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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,489	10/07/2003	Mie Yoshino	243661US2CONT	4038

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
BRAUN, FRED L	

ART UNIT	PAPER NUMBER
2852	

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	10/679,489	YOSHINO, MIE	
	Examiner	Art Unit	
	Fred L. Braun	2852	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/754,061.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/07/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 1, 2, 5-7 and 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are considered to fail to particularly point out and distinctly claim the invention, as required by the statutes, because the claimed recitation that "said roller portion has a volume resistively ranging from 0 ohms. cm to 10^7 ohms.cm" appearing on lines 14 and 15 of base claims 1 and 11, respectively; lines 16 and 17 of base claim 5; and lines 17 and 18 of base claim 13, respectively, includes a situation where the volume resistivity of the developing roller is 0 ohms. cm which means that it is has no volume resistivity at all thereby rendering said base claims and any claims dependent thereon indefinite.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In*

re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-15, respectively, insofar as being definite, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, respectively, of U.S. Patent No. 6,636,716 to Yoshino. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the subject application, noted supra, are essentially verbatim the claims of U.S. Patent No. 6,636,716 to Yoshino except for the fact that base claims 1, 5, 11 and 13, respectively, add the recitation or limitation that the roller portion has a surface potential substantially equal to a bias for development while base claims 3 and 8, respectively, of U.S Patent No. 6,636,716 to Yoshino further recite that the roller portion has a ten-point mean surface roughness so as to reduce irregularities on a surface of the development liquid on the roller portion. Accordingly, it is submitted that the claims of the subject application are not patentably distinct from the subject matter being claimed in the commonly owned patent to Yoshino (6,636,716) and that issuance of a second patent would provide an unjustified extension of the term of the right to exclude granted by a patent. See Eli Lilly & Co. v Barr Labs, Inc., 251 F.3d 955, 58 USPQ 2d 1865 (Fed. Cir. 2001).

6. Claims 3 and 8 are further rejected under 35 U.S.C. 102(b) as being anticipated by Iino et al ('148).

It is submitted that the patent to Iino et al ('148) fully discloses the developing unit and/or the image forming apparatus recited in claims 3 and 8, respectively. More specifically, element 202 (Fig. 3) of Iino et al ('148) is the liquid developing roller which contacts the latent image carrier 1 (Fig. 3) (column 6, lines 60-63) while carrying a developing liquid consisting of a carrier liquid and a developing substance thereon (column 4, lines 33-38) for developing the latent image formed on said image carrier by depositing developing liquid on said latent image wherein said roller portion or outer surface of said developing roller has a ten-point mean surface roughness of 3μm or less (column 9, lines 28 and 29; and column 14, lines 45-52 of Iino et al ('148).

7. Claim 10 is further rejected under 35 U.S.C. 103(a) as being unpatentable over Iino et al ('148) as applied to claims 3 and 8 above, and further in view of Hosoya et al.

The patent to Hosoya et al (column 10, lines 14-16 and 40-55, respectively) suggests to one having ordinary skill in the art that the use of an amorphous silicon series photosensitive body is desirable because it exhibits excellent mechanical durability.

Therefore, to use a photosensitive body or image carrier in the liquid developer unit or device of Iino et al ('148) that is formed of amorphous silicon (a-Si) so that it exhibits excellent mechanical durability, as suggested by Hosoya et al, would be an obvious modification of the prior art to one having ordinary skill in the art at the time applicant's invention was made.

8. Any inquiry concerning this communication should be directed to Fred L Braun at telephone number (571) 272-2132.

Fred L Braun
FRED L BRAUN
PRIMARY EXAMINER
ART UNIT 2852